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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,848	01/21/2005	Minne Van Der Veen	NL 020670	6183

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P.O. BOX 3001
BRIARCLIFF MANOR, NY 10510

EXAMINER	
SCHWARTZ, DARREN B	
ART UNIT	PAPER NUMBER
2435	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/521,848	VAN DER VEEN ET AL.	
	Examiner	Art Unit	
	DARREN SCHWARTZ	2435	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 September 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6 and 8-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6 and 8-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Applicant amends claims 1, 3, 4, 6, 8 and 10.

Claims 1-6 and 8-10 are presented for examination.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 15 September 2009 has been entered.

Response to Arguments

Applicant's arguments with respect to claims 1-6 & 8-10 have been considered but are moot in view of the new grounds of rejection. The Examiner addresses issues raised by applicant.

1. In light of the amendments to the claims, the Examiner withdraws the rejections under 35 U.S.C. 112, second paragraph.

2. Applicant argues on page 8 of Remarks, "Although, Levy, paragraph [0054], discloses that in some implementations, a fingerprint is used to find a set of potential matches, Levy does not disclose any criteria for the set of potential matches.

Specifically, Levy does not teach or suggest that the set of fingerprints meet a predefined proximity criterion, as claimed."

The Examiner disagrees. Levy et al (U.S. Pat Pub 2003/0021441 A1), hereinafter referred to as Levy clearly states in ¶54: "A fingerprint of the audio signal is compared against the fingerprints in the database to find a match or a closest approximation. In some implementations, a fingerprint is used to find a set of potential matches."

3. Applicant argues on page 6 of Remarks: "Therefore, in the watermarking and fingerprinting techniques disclosed by Levy, the watermark is first used to determine a subset of songs and then a fingerprint is calculated to identify the song." Applicant further argues "Clearly, Levy teaches a different approach to identify the data sequence (watermarks followed by fingerprints) from that of the claimed invention (fingerprints followed by watermarks.)"

The Examiner disagrees and Applicant's and applicant's representative are reminded that a prior art reference must be considered in its entirety, i.e. as a whole, including portions that would lead away from the claimed invention; see W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) [MPEP: 2141.02 VI].

Levy states in ¶133: "We also note that an alternative implementation of the FIGS. 3 and 4 system is for a user device to decode a digital watermark embedded in an audio signal and to compute a fingerprint or hash of the audio signal, and then

communicate the watermark (or watermark identifier) and fingerprint to a server/database." This suggests that Levy may reverse the order of elements in its principles of operation without deviating or destroying those elements and respective teachings of Levy.

4. In addressing the claims following this section, the Examiner notes Applicant claims "if multiple second fingerprints are matched that meet a predefined proximity criterion with the first fingerprint ... otherwise ..." The art applied need meet only one condition.

The fact that the Examiner may not have specifically responded to any particular arguments made by Applicant and Applicant's Representative, should not be construed as indicating Examiner's agreement therewith.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 4 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Shuster (U.S. Pat 6826546 B1), hereinafter referred to as Shuster.

Re claims 1, 4 and 8: Shuster teaches a method for identifying a first digital sequence, a system for identifying a first digital data sequence (col 4, lines 39-42), a method for enabling identification of a first digital data sequence (col 5, lines 30-35), comprising:

calculating a first digital fingerprint based on at least part of the first sequence (Fig 1, elt 136; col 6, lines 6-9),

comparing the first fingerprint with a plurality of second fingerprints respectively associated with a plurality of second digital data sequences (Fig 1, elts 140 & 144; col 6, lines 9-12),

if multiple second fingerprints are matched that meet a predefined proximity criterion with the first fingerprint, calculating a digital watermark associated with the first data sequence and comparing the calculated digital watermark with watermarks respectively associated with the matched multiple second fingerprints' respectively associated second digital data sequences in order to establish an identity of the first digital data sequence; otherwise, the first fingerprint is established as unique (The Examiner reads the alternative condition as "if multiple second fingerprints are not matched that meet a predefined proximity criterion with the first finger, the first fingerprint is established as unique;" Shuster: Fig 1, elts 144, 148 & 152; col 6, lines 15-19; col 6, lines 37-38).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-6 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levy et al. (U.S. Pat Pub 2003/0021441 A1), hereinafter referred to as Levy, in view of Lofgren et al. (U.S. Pat Pub 2002/0154144 A1), hereinafter referred to as Lofgren.

Re claims 1, 4 and 8: Levy teaches a method, a system for identifying a first digital data sequence and a method for enabling identification of a first digital data sequence (Abstract; ¶9; ¶10), comprising:

calculating a first digital fingerprint based on at least part of the first sequence (¶51),

comparing the first fingerprint with a plurality of second fingerprints respectively associated with a plurality of second digital data sequences (¶54, lines 33-36),

multiple second fingerprints are matched that meet a predefined proximity criterion with the first fingerprint (¶54, lines 33-36; ¶57; ¶58, lines 1-3),

calculating a digital watermark associated with the first data sequence (Abstract, lines 5-7).

However, Levy does not expressly disclose comparing the calculated digital watermark with watermarks respectively associated with the matched second digital data sequences in order to establish an identity of the first digital data sequence.

Lofgren teaches calculating a digital watermark associated with the first data sequence (¶37, lines 6-8; ¶45, lines 1-2; ¶46, lines 2-3; ¶47); comparing the calculated digital watermark with watermarks respectively associated with the matched second digital data sequences in order to establish an identity of the first digital data sequence (¶38; ¶46, lines 2-3; ¶47; ¶49, lines 3-8; ¶51-¶52; ¶65; ¶73).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Levy with the teachings of Lofgren, for the purpose of indexing, searching & retrieving information expediently.

Re claims 2, 5 and 9: The combination of Levy and Lofgren teaches calculating the digital watermark associated with the first data sequence, is dependent on information contained in the first fingerprint (Levy: ¶54: lines 15-21 & lines 33-36; ¶57-¶58; Lofgren: ¶47; ¶49).

Re claims 3, 6 and 10: The combination of Levy and Lofgren teaches calculating the digital watermark associated with the first data sequence is dependent on information resulting from the comparison between the first fingerprint and the plurality of second fingerprint (Levy: ¶51; ¶54: lines 15-21 & lines 33-36; ¶57-¶58; Lofgren: ¶47; ¶49; ¶52).

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the text of the passage taught by the prior art or disclosed by the examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DARREN SCHWARTZ whose telephone number is (571)270-3850. The examiner can normally be reached on 7am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571)272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. S./
Examiner, Art Unit 2435
/Kimyen Vu/
Supervisory Patent Examiner, Art Unit 2435